



AF
JFW

KINNEY & LANGE

A PROFESSIONAL ASSOCIATION

PATENT, TRADEMARK,
COPYRIGHT, AND RELATED
INTELLECTUAL PROPERTY LAW

THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS, MINNESOTA 55415-1002

INFO@KINNEY.COM
FACSIMILE (612) 339-6580
TELEPHONE (612) 339-1863

Alan M. Koenck
(612) 337-9360
amkoenck@kinney.com

September 6, 2006

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: U.S. Patent Application of Christopher M. Glenna
Appln. No. : 10/664,429
Filed : September 16, 2003
Title : Tape Roll Tab Application Method and Article
Docket No. : 54093US010

Dear Sir:

Enclosed for filing are the following papers in connection with the above-identified patent application:

1. Reply Brief for Appellant
2. Postcard

Respectfully submitted,

KINNEY & LANGE, P.A.

Alan M. Koenck

AMK:owk
Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor	: Christopher M. Glenna	
Appln. No.	: 10/664,429	
Filed	: September 16, 2003	Group Art Unit: 1772
Title	: TAPE ROLL TAB APPLICATION METHOD AND ARTICLE	Examiner: N. Ahmad
Docket No.	: 54093US010	

REPLY BRIEF FOR APPELLANT

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I CERTIFY THAT THIS PAPER IS BEING SENT BY U.S. MAIL, FIRST CLASS, TO THE ASSISTANT COMMISSIONER FOR PATENTS, ALEXANDRIA, VA 22313, THIS 6 DAY OF

September, 2006.

PATENT ATTORNEY

This brief is in response to the Examiner's Brief filed in the above-identified Appeal.

In responding to the Applicant's arguments that the requisite suggestion or motivation to modify the teachings of Dills with the teachings of Hammond is lacking (presented in the Appeal Brief filed on April 7, 2006), the Examiner pointed to the Hammond patent as teaching that "the tab strip can be with or without holes and can be with or without adhesive thereon." The Examiner then contended that "when the strip has holes with adhesive, it would be equivalent in function to the tap (sic) strip with hole and no adhesive as taught by Dills." Further explaining this theory the Examined stated that "it is noted that the rejection is based on obvious functional equivalency of the tab with hole and adhesive to tab with hole and without adhesive. Applicant is also directed to Hammond, col. 3, lines 5-10 wherein it is stated that the holes provides (sic) for adhesion between the gummed face of the tap (sic) and the coiled body (which would be the penultimate layer)."

The Applicant believes that both this approach and conclusion are improper. First, merely identifying two different teachings as "functional equivalents" is not sufficient to satisfy the requirement of a suggestion or motivation to combine teachings. As noted in M.P.E.P. 2144.06, "In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure *or the mere fact that the*

components at issue are functional or mechanical equivalents" (emphasis added). No evidence of a suggestion or motivation to apply a particular teaching of Hammond (providing adhesive on the inward-facing surface of the tab) to the teachings of Dills (which discloses a tab having an opening so that the inward-facing surface of the tape projects through the tab to adhere the tape and the tab to the roll) has been pointed out in the record. The Applicant has specifically pointed out reasons why one of ordinary skill in the art would not have had any motivation to apply this particular teaching of Hammond to the teachings of Dills (such as the fact that adding adhesive to the inward-facing surface of the Dills tab would provide no additional utility because of the already-existing opening in the Dills tab that allows the tape itself to adhere the tab to the roll, and the explicit disclosure in the Dills patent noting the problems with tabs that have adhesive on their inward-facing surface (see column 1, lines 22-29 of the Dills patent)). Thus, the record does not support the Examiner's contention that the tab with a hole and without adhesive disclosed by Dills is a functional equivalent of the tab with a hole and with adhesive allegedly disclosed by Hammond, and even if these two structures are functionally equivalent at some level, the prior art did not recognize any such equivalency, as evidenced by Dills' disclosure of problems associated with adhesive tabs as an explanation for why the Dills tab is non-adhesive.

More basically, the Examiner's position departs from the underlying basis of determining whether a proposed combination or modification of prior art teachings is obvious, which is set forth in M.P.E.P. 2143.01 as follows:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)(emphasis added). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

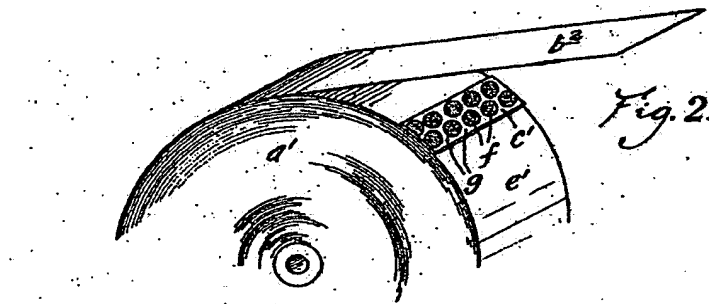
Without the benefit of the Applicant's disclosure, one of ordinary skill in the art would not have any reason to modify the teachings of Dills with the teaching of Hammond proposed by the Examiner. The goal of a tape roll with a tab is to provide a mechanism for more readily pulling the tape off of the roll, while keeping the end of the tape adhered to the roll (so that the tape does not flap off of the roll). The Dills tape roll provides a tab that is non-adhesive, is located so that the end of the tape falls within the length of the tab, and includes an opening so that the tape projects through the tab to hold the tape (and tab) to the roll. The Hammond tape roll provides a tab that is adhesive, and is located so that the end of the tape "overtabs" the tab (extends beyond the length of the tab). As the Examiner has noted, on the left-hand column of page 2, at lines 5-10, Hammond discloses an alternative embodiment in which the tab is not adhesive, and holes are provided to allow the adhesive of the tape to adhere to the tape roll. However, none of the teachings of Hammond would suggest to one of ordinary skill in the art that there is any desirability to modifying the tab of Dills to be adhesive (for the reasons discussed above and in the previously filed Appeal Brief, which points out that the tape projecting through the tab opening provides the necessary adhesion in the Dills product, and that the Dills patent explicitly discussed the problems associated with adhesive tabs), and there is no attempt in the record to supply this suggestion. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. 2143.01, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)(emphasis added).

The Applicant therefore respectfully submits that the Examiner's reliance on a notion that the Dills patent and the Hammond patent disclose tab configurations that are "functionally equivalent" ignores the contrary disclosure of Dills indicating that adhesive and non-adhesive tabs are not equivalent, and also neglects the requirement to show that one of ordinary skill in the art would have been able to recognize the desirability of the proposed combination of the teachings of Dills and Hammond, based on a suggestion in the references or elsewhere in the record. Because the prerequisites for combining the teachings of Dills and Hammond have not been satisfied, the combination of these references in the manner suggested by the Examiner is improper.

With respect to claims 16, 17 and 20, the Examiner again contended that the spatial recitations of claim 16 were satisfied by Hammond. The recitations at issue (relating to a tab having first and second ends, an adhesive portion having first and second ends, and a non-adhesive portion having first and second ends) read as follows:

- (1) the first end of the non-adhesive portion coinciding with the first end of the tab
- (2) the first end of the adhesive portion being located adjacent to the second end of the non-adhesive portion
- (3) the second end of the adhesive portion coinciding with the second end of the tab

The Examiner points to Figure 2 of Hammond as satisfying these elements. This figure is reproduced below:



For element (1), the Examiner contended that "a first end portion of non-adhesive portion (f) coincides with a first end of the tab (see the area of (f) located along the edge at the near side of the tab)." For element (2), the Examiner contended that "the first end portion of the adhesive (g) is located adjacent the second end portion of the non-adhesive portion (f)...." For element (3), the Examiner contended that "the first end position of adhesive (g) coincides with the second end of the tab (see figure-2, the far edge of the tab)."

This reading of Hammond is not understandable. The non-adhesive portions (f) and the adhesive portions (g) of the Hammond tab are interspersed with one another, and therefore it is not understandable to define first and second ends of these portions, as recited by claim 16. The Examiner appears to have selected a single non-adhesive circular portion (f), and noted that one side of this circle appears to be adjacent a near end of the tab. The Examiner then appears to define an end of the non-adhesive portion (g) as being adjacent the opposite side of this circle (by stating that "the first end portion of the adhesive (g) is located adjacent the second end portion of the non-adhesive portion (f)..."). The Applicant disagrees with this interpretation -- *it is improper to define a middle portion of the non-adhesive portion (g) as an end for the purpose of satisfying this claim element*, particularly when there is no support in the Hammond patent for calling this middle portion an end. The adhesive portion (g) of Hammond actually has a first end that coincides with a first end of the tab and a second end that coincides with the second end of the tab; neither end is adjacent to a second end of the non-adhesive portion (f) (located in the middle of the tab) that has been selected as satisfying element (1). The Applicant therefore reasserts that the spatial definitions recited in claim 16 are not disclosed by the combination of Dills and Hammond.

First Named Inventor: Christopher M. Glenna

Application No.: 10/664,429

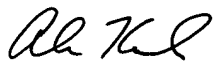
-6-

CONCLUSION

In view of the foregoing remarks, and those made in the Appeal Brief filed on April 7, 2006, the rejections of all of the claims on appeal (15-17 and 19-30) should be withdrawn.

Respectfully submitted,

KINNEY & LANGE, P.A.

By: 

Alan M. Koenck, Reg. No. 43,724
THE KINNEY & LANGE BUILDING
312 South 3rd Street
Minneapolis, MN 55415-1002
Telephone: (612) 339-1863
Fax: (612) 339-6580

AMK